

REMARKS

A telephonic interview was held on July 19, 2005 between Examiner Carolyn Bleck and Applicant's representative Jack Friedman. In the interview, the Examiner stated that the claimed content of the tag on the first asset of claims 1, 13, and 24 does not impart functionality in the method steps and suggested adding the feature of utilizing the claimed content of the tag in a manner that manipulatively affects performance of one or more method steps in the claims. In response, Applicant's representative agreed to amend the claims in accordance with the preceding suggestion by the Examiner. Accordingly, the amendment herein amends the claims in accordance with the preceding suggestion by the Examiner. No new matter has been added by the amendment herein.

In the interview, the Examiner also suggested a need to ascertain whether the phrase of "assigning a unique identifier to each said" in claim 1 (and similar language in claims 13 and 24) is redundant in view of the claimed tag and its content. In response, Applicants' representative agreed to ascertain whether said phrase is redundant. Accordingly, the amendment herein amends the claims to delete said phrase, inasmuch as said phrase appears to be redundant.

The Examiner rejected claims 30-33, 36-37, and 43 under 35 U.S.C. §112, second paragraph.

The Examiner rejected claims 1, 7, 13, 24, 26, 27, 34-35, 38-39, and 43-54 under 35 U.S.C. §103(a) as allegedly being unpatentable over Maloney (6,392,543) in view of PALM (PALM User's Manual, September 1989) and Maynard (5,949,335).

The Examiner rejected claims 3-4, 15-16, 25, 28-29, and 40-41 under 35 U.S.C. §103(a) as allegedly being unpatentable over Maloney (6,392,543), PALM (PALM User's Manual,

September 1989), and Maynard (5,949,335) as applied to claims 1, 13, 24 above, and further in view of Guthrie et al. (5,289,372).

Applicant respectfully traverses the §112 and §103 rejections with the following arguments.

**35 U.S.C. §112, Second Paragraph**

The Examiner rejected claims 30-33, 36-37, and 43 under 35 U.S.C. §112, second paragraph.

Since claims 30-33 and 36-37 have been canceled, Applicant respectfully contends that the rejections of claims 30-33 and 36-37 under 35 U.S.C. §112, second paragraph.

As to claim 43, the Examiner states: "Claim 43, line 1, lacks proper antecedent basis. Claim 43 depends on claim 42, which has been cancelled. For purposes of applying prior art, claim 43 is assumed to depend on claim 1." In response, Applicant has amended claim 43 to depend from claim 1.

Accordingly, Applicant respectfully requests that the rejections under 35 U.S.C. §112, second paragraph be withdrawn.

**35 U.S.C. §103(a)****Claims 1, 7, 13, 24, 26, 27, 34-35, 38-39, and 43-54**

The Examiner rejected claims 1, 7, 13, 24, 26, 27, 34-35, 38-39, and 43-54 under 35 U.S.C. §103(a) as allegedly being unpatentable over Maloney (6,392,543) in view of PALM (PALM User's Manual, September 1989) and Maynard (5,949,335).

Applicant respectfully contends that claims 1, 13, and 24 are not unpatentable over Maloney in view of PALM and Maynard, because Maloney in view of PALM and Maynard does not teach or suggest each and every feature of claims 1, 13, and 24. For example, Maloney in view of PALM and Maynard does not teach or suggest the features of claim 1:

"tagging a first asset of said assets with a tag, said first asset being a computer software asset, said tag comprising an asset tag barcode, a part number or serial number barcode, and a Software Distribution System (SDS) number, said SDS number comprising first, second, and third contiguously sequenced fields, said first field consisting of a venue code identifying a first destination site of the plurality of sites for the first asset, said second field consisting of a software type of the first asset, said third field consisting of a consecutive number index of the software type that makes the first asset unique for the software type at the first destination site" and

"receiving the tagged first asset at the destination site, said receiving comprising capturing the asset tag barcode and the SDS number from the tag of the tagged first asset to verify entry of the first asset at the destination site, being a new current location, in said database."

and similar features of claims 13 and 24.

The Examiner argues:

"As per the recitation of "a tag comprising an asset tag barcode, a part number, or a serial number barcode, and a SDS number, said SDS number..." the Examiner respectfully submits that the differences between the prior art and the tag in claim 1 is only found in the nonfunctional descriptive material and is not functionally involved in the step recited. The step of tagging an item would be performed the same regardless of the data on the tag. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994). For further guidance, note MPEP § 2106, common situations involving nonfunctional descriptive material are: "a process that differs from the prior art only with respect to nonfunctional descriptive material that cannot alter how the process steps are to be performed to achieve the utility of the invention." ... However, even if it is assumed the data on the tag is given patentable weight, the Examiner respectfully submits that to be entitled to such weight in method claims, the recited structural limitations therein must affect the method in a manipulative sense and not to amount to the mere claiming of a use of a particular structure, which, appears to be the case here. *Ex parte Pfeiffer*, 135 USPQ 31 (BdPatApp&Int 1961). For example, the tag would have to be used in another step in the method claim, such as a step of recording a location based on the tag, for the specific tag to be given patentable weight."

In response, Applicants respectively contend that the aforementioned amended feature of "receiving the first asset at the destination site, said receiving comprising capturing the asset tag barcode and the SDS number from the tag of the tagged first asset to verify entry of the first asset at the destination site, being a new current location, in said database" affects the method in a manipulative sense and conforms with the Examiner's suggestion for amending the claims such that the feature of "a tag comprising an asset tag barcode, a part number, or a serial number

barcode, and a SDS number, said SDS number..." will have patentable weight.

In addition, Applicant respectfully contends that Maloney in view of PALM and Maynard does not teach or suggest said "receiving the first asset at the destination site, said receiving comprising capturing the asset tag barcode and the SDS number from the tag of the tagged first asset to verify entry of the first asset at the destination site, being a new current location, in said database".

Based on the preceding arguments, Applicants respectfully maintain that claims 1, 13, and 24 are not unpatentable over Maloney in view of PALM and Maynard , and that claims 1, 13, and 24 are in condition for allowance.

Since claims 7, 26, 27, and 43-47 depend from claim 1, Applicants contend that claims 7, 26, 27, and 43-47 are likewise in condition for allowance.

Since claims 34-35 and 48-54 depend from claim 13, Applicants contend that claims 34-35 and 48-54 are likewise in condition for allowance.

Since claims 38-39 depend from claim 24, Applicants contend that claims 38-39 are likewise in condition for allowance.

Claims 3-4, 15-16, 25, 28-29, and 40-41

The Examiner rejected claims 3-4, 15-16, 25, 28-29, and 40-41 under 35 U.S.C. §103(a) as allegedly being unpatentable over Maloney (6,392,543), PALM (PALM User's Manual, September 1989), and Maynard (5,949,335) as applied to claims 1, 13, 24 above, and further in view of Guthrie et al. (5,289,372).

Since claims 3-4 and 28-29 depend from claim 1, which Applicants have argued *supra* to

not be unpatentable over Maloney in view of PALM and Maynard under 35 U.S.C. §103(a). Applicants maintain that claims 3-4 and 28-29 are likewise not unpatentable over Maloney, PALM, and Maynard , and further in view of Guthrie.

Since claims 15-16 depend from claim 13, which Applicants have argued *supra* to not be unpatentable over Maloney in view of PALM and Maynard under 35 U.S.C. §103(a), Applicants maintain that claims 15-16 are likewise not unpatentable over Maloney, PALM, and Maynard , and further in view of Guthrie.

Since claims 25 and 40-41 depend from claim 24, which Applicants have argued *supra* to not be unpatentable over Maloney in view of PALM and Maynard under 35 U.S.C. §103(a), Applicants maintain that claims 25 and 40-41 are likewise not unpatentable over Maloney, PALM, and Maynard , and further in view of Guthrie.

CONCLUSION

Applicants respectfully believe that all pending claims and the entire application meet the acceptance criteria for allowance and therefore request favorable action. If the Examiner believes that anything further would be helpful to place the application in better condition for allowance, Applicants invites the Examiner to contact Applicants' representative at the telephone number listed below. The Director is hereby authorized to charge and/or Deposit Account 09-0457.

Date: 10/10/2005  
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